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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,823	10/30/2003	Karine Marion	114120	7973

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EXAMINER	
WARE, DEBORAH K	

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,823	MARION, KARINE	
	Examiner	Art Unit	
	Deborah K. Ware	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *11-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/23/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-22 are pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on October 31, 2002. It is noted, however, that applicant has not filed a certified copy of the 02.13963 application as required by 35 U.S.C. 119(b). Further, the application claims priority benefit of 60/422,508 filed October 31, 2002.

Miscellaneous Papers

The Preliminary amendments filed October 30, 2003, and December 29, 2004, have been received and entered. Furthermore, the Power of Attorney filed December 23, 2004, is acknowledged.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on December 23, 2004 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Election

Applicant's election with traverse of Group I, claims 1-10, in the reply filed on July 18, 2006 is acknowledged. The traversal is on the ground(s) that each of the claims of Group I, II and III have an identical purpose and a thorough search for the subject matter of one group will encompass a search for the other groups and hence no serious burden. This is not found persuasive because each group has its own separate

classification, thereof, and a reference found in one class will not necessarily encompass and read on the subject matter of the claims for each of Groups I, II and III.

Therefore, a serious burden is placed upon the Examiner to search all of these different groups. Furthermore, a product claim is not necessarily given any patentable weight based upon its intended purpose, and a reference which may read on the product may not read on the process claims. Thus, one-way distinctness is present between the process and product claims. Also two-way distinctness is present between the product and kit since the product is an enzyme mixture and the kit can be just one solution. Also the process of removing a biofilm is required to use two separate solutions and in a particular order too. It can not use one solution as required of Group II in the form of a kit or a mere enzyme mixture as required of Group III.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-22 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 18, 2006, noted above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are rendered vague and indefinite for failing to recite clear and distinct process steps wherein it is unclear in step c) what is intended by circulation. What does this term mean in step c)? The metes and bounds of the claim can not be determined. Further, the steps for preparing the solution of step b) are not described and clearly set forth in the claim. Also in claim 2 the step for preparing a solution comprising an acid is not clearly set forth either.

Regarding claims 3, 4, 5, and 9 the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Also claim 10 is unclear with respect to "chosen from the group formed by" wherein the language reads on a production step and it is suggested to change the language to Makush type language –selected from the group consisting of-- and then just list the acids thereafter. Also deletion of the redundant language "in the acid for removing deposits of mineral salts," is suggested.

Claim Rejections - 35 USC § 102

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Xu (US 6,777,223 having benefit of priority to June 19, 2000), disclosed on enclosed PTO-892 Form.

Claims are drawn to method of removing a biofilm.

Xu teaches method of removing a biofilm comprising carrying out by washing a surface to be treated with a) a solution comprising an enzyme mixture (see columns 7-9, lines 15-65) of proteases, esterases, lipases, galactosidase, and amylase, and b) applying an alkaline solution of detergent containing surfactant (see column 7, lines 15-25). Further, amino acids are disclosed to be present or prepared in response to enzymatic activity of the solution, note column 4, lines 20-30.

The claims are identical to the teachings of Xu and are considered to be anticipated by the teachings therein. Furthermore, in terms of the washing step, although the reference teaches contacting step, the presence of the detergent would inherently include washing to be a function of the disclosed contacting step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu, discussed above, in view of Barbeau et al (US 6,762,160) and Carpenter et al (US 5,238,843), all cited on enclosed PTO-892 Form.

Claims are further drawn to an enzyme mixture which is pancreatin (a protease), a disinfectant (hypochlorite) and an acid for removing the deposits that is citric acid.

Xu and claims are discussed above.

Claims differ from Xu in that pancreatin, hypochlorite and citric acid are not disclosed.

Barbeau et al teach citric acid (note column 7, line 57 and column 8, lines 58-63) and disinfectant (note column 8, lines 58-67 and column 9, line 1).

Carpenter et al teach pancreatin to be useful enzyme for treating a surface that contain biofilms, note column 1, line 58 and column 16, line 34.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the teachings of Xu, Barbeau et al and Carpenter et al in order to provide for removing biofilms from a surface because each of pancreatin, hypochlorite and citric acid have all been used for the same purpose, and washing surfaces and removing biofilms, therefrom. Therefore, one of skill would have expected successful results applying these solutions to a surface by washing the surface. Clearly one of skill would have been motivated to select citric acid, hypo-chlorite and pancreatin because of they are well known in the cited prior art. In the absence of persuasive evidence to the contrary the claims are deemed prima facie obvious.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware
September 30, 2006